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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/631,230	07/31/2003	George C. Lackey	74123-001	1726

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HUSCH & EPPENBERGER, LLC
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ST. LOUIS, MO 63105-3441

EXAMINER

CLEMENT, MICHELLE R

ART UNIT	PAPER NUMBER
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3641

DATE MAILED: 04/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/631,230

Applicant(s)

LACKEY, GEORGE C.

Examiner

Michelle (Shelley) Clement

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) 3 and 7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-6 and 8-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection as necessitated by applicant's amendments.

Claim Rejections - 35 USC § 102 & § 103

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 2, and 6 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Paden (US Patent # 3,302,497). Paden discloses a device that is inherently capable of performing the claimed function of being used as a firearm supporting apparatus and is suitable for use with shafts of varying diameters and lengths, the device including: an elongated support member (reference 12) having an end surface and a top surface, wherein the end surface further comprises a clamping surface (reference 90) and the top surface further comprises a surface that could be used to support a firearm and the clamping surface and the supporting surface are attached with the elongated support member; a collar (reference 50) connected with the elongated support member; and an adjustable

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mechanism (reference 16) connecting the collar with the elongated support member and adjusting the position of the collar relative to the clamping surface of the support member, resulting in movement of the collar relative to the clamping surface in a direction parallel to the elongated support member, the collar and clamping surface securing the support member to the shaft. The adjustable mechanism includes an elongated threaded member (reference 30) connected with the collar and the elongated support member and a fastening device (reference 22) associated with the threaded member, wherein tightening and loosening the fastening device on the threaded member adjusts the position of the collar relative to the clamping surface, the clamping surface includes upper and lower support arms which defines a collar slot separating the upper and lower support arms (Figure 1). Although Paden does not expressly disclose the clamping surface and the supporting surface being integral with the elongated support member, it would have been obvious to one having ordinary skill in the art at the time the invention was made to do so, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893). It is noted that the [a) statements of intended use or field of use, b) "adapted to" or "adapted for" clauses, c) "wherein" clauses, or d) "whereby"] clauses are essentially method limitations or statements of intended or desired use. Thus, these claims as well as other statements of intended use do not serve to patentably distinguish the claimed structure over that of the reference. See *In re Pearson*, 181 USPQ 641; *In re Yanush*, 177 USPQ 705; *In re Finsterwalder*, 168 USPQ 530; *In re Casey*, 512 USPQ 235; *In re Otto*, 136 USPQ 458; *Ex parte Masham*, 2 USPQ 2nd 1647.

See MPEP § 2114 which states:

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A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ 2nd 1647

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than functions. *In re Danly*, 120 USPQ 528, 531.

Apparatus claims cover what a device is not what a device does. *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 15 USPQ2d 1525, 1528.

As to limitations which are considered to be inherent in a reference, note the case law of *In re Ludtke*, 169 USPQ 563, *In re Swinehart*, 169 USPQ 226, *In re Fitzgerald*, 205 USPQ 594, *In re Best et al.*, 195 USPQ 430, and *In re Brown*, 173 USPQ 685, 688.

5. Claims 4, 5, and 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paden as applied to claim 1 above, and further in view of Kopelman et al. (US Patent # 5,829,099). Although Paden does not disclose the elongated support member being contoured or including a flexible material with a non-skid surface covering, Kopelman et al. does. Kopelman et al. teaches a universal ergonomic handle design, which can replace handles of various tools. The handle comprising a contoured surface, which could be described as including a concave cradle (Figures 1-4), and further includes a flexible material and is preferably textured (i.e. non-skid) to provide friction associated with good grip (column 4, lines 40-45). Paden and Kopelman et al. are analogous art because they are from the same field of endeavor: hand tools. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the ergonomic grip as taught by Kopelman et al. with the gripping device as taught by Paden. The suggestion/motivation for doing so would have been to prevent injuries as taught by Kopelman et al. at column 1, lines 25-30.

6. Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paden as applied to claim 1 above, and further in view of Knight (US Patent # 3,805,646). Although Paden does not expressly disclose the clamping surface being concave or covered by a flexible

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material, Knight does. Knight teaches a gripping tool wherein the clamping surface (reference 56) is concave and covered by a flexible material (reference 58) so that the outer surface of the pipe will not be marred. Paden and Knight are analogous art because they are from the same field of endeavor: hand wrenches. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the concave clamping surface as taught by Knight with the grippers as taught by Paden. The suggestion/motivation for doing so would have been to obtain a tool that would not mar the surface of the item that was being worked on.

7. Claims 1 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scholl et al. (EP 618045). Scholl et al. discloses a device that is inherently capable of performing the claimed function of being used as a firearm supporting apparatus and is suitable for use with shafts of varying diameters and lengths, the device including: an elongated support member (reference 4) having an end surface and a top surface, wherein the end surface further comprises a clamping surface (reference 15) and the top surface further comprises a surface that could be used to support a firearm and the clamping surface and the supporting surface are integral with the elongated support member; a collar (reference 2) connected with the elongated support member; and an adjustable mechanism (reference 3) connecting the collar with the elongated support member and adjusting the position of the collar relative to the clamping surface of the support member, resulting in movement of the collar relative to the clamping surface in a direction parallel to the elongated support member, the collar and clamping surface securing the support member to the shaft. It would have been obvious to include collar of varying diameters (extra long for very large objects-and selecting the appropriate one as required), since it has been held that the provision of adjustability, where needed, involves only routine skill in the art. It is

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noted that the [a) statements of intended use or field of use, b) "adapted to" or "adapted for" clauses; c) "wherein" clauses, or d) "whereby"] clauses are essentially method limitations or statements of intended or desired use. Thus, these claims as well as other statements of intended use do not serve to patentably distinguish the claimed structure over that of the reference. See *In re Pearson*, 181 USPQ 641; *In re Yanush*, 177 USPQ 705; *In re Finsterwalder*, 168 USPQ 530; *In re Casey*, 512 USPQ 235; *In re Otto*, 136 USPQ 458; *Ex parte Masham*, 2 USPQ 2nd 1647.

See MPEP § 2114 which states:

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ 2nd 1647

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than functions. *In re Danly*, 120 USPQ 528, 531.

Apparatus claims cover what a device is not what a device does. *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 15 USPQ2d 1525, 1528.

As to limitations which are considered to be inherent in a reference, note the case law of *In re Ludtke*, 169 USPQ 563, *In re Swinehart*, 169 USPQ 226, *In re Fitzgerald*, 205 USPQ 594, *In re Best et al.*, 195 USPQ 430, and *In re Brown*, 173 USPQ 685, 688.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Ballard (US Patent # 3,752,016), Seppola (US Patent # 2,932,226), Dunoyer (US Patent # 1,816,723), and Dumont (US Patent # 6,196,090).

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michelle (Shelley) Clement whose telephone number is 571.272.6884. The examiner can normally be reached on Monday thru Thursday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Carone can be reached on 571.272.6873. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to be "H. Clement", is located in the bottom right corner of the page.